

REMARKS

Claims 13 and 15-17 are pending in the present application. Claims 1-12 and 18-20 have been withdrawn. Claims 21-25 have been added. Applicant submits that the newly added claims introduce no new matter.

The Examiner issued a Notice of Non-Compliant Amendment dated July 28, 2008 indicating the list of claims does not include the text of all pending claims, including withdrawn claims. Applicant has revised the response to include the text associated with claims 1-12 and 18-20 as requested.

As previously stated, this Amendment is in response to the Office Action mailed April 8, 2008. In the Office Action, the Examiner rejected claims 13 and 15-17 under 35 U.S.C. §103(a). We disagree with the outstanding §103(a) rejection and respectfully request reconsideration of this rejection in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

In the Office Action, claims 13 and 15-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2004/0063455A1 issued to Eran et al. ("Eran") in view of U.S. Publication No. 2004/0039817 issued to Lee et al. ("Lee"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* §2143, p. 2100-126 to 2100-130 (8th Ed., Rev. 5, August 2006). Applicant respectfully submits that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Eran and Lee, taken alone or in any combination, do not disclose or render obvious, at least one of: (1) setting a plurality of received signal strength indicator (RSSI) thresholds including a first RSSI threshold and a second RSSI threshold having a value lower than the first

RSSI threshold; (2) placing an address of the station into a list identifying stations located in a potential coverage hole if none of the plurality of access points computes a RSSI value of the management message above the second RSSI threshold; and (3) removing the address of the station from the list if one of the plurality of access points computes the RSSI value of the management message above the first RSSI threshold, as recited in claim 13.

As admitted by the Examiner, Erin does not expressly disclose elements (1)-(3), as above (Office Action, page 3, paragraph 2). The Examiner alleges that Lee discloses these elements of the claim. Applicant respectfully disagrees and submits that the Examiner cites to the language in claim 1 of Lee (Office Action, pages 3-4). Applicants respectfully submit that it is impermissible to rely on the language in the claims as support for the teachings of Lee. The scope of a patent's claims determines what infringes a patent; it is no measure of what it discloses. In re Benno, 768 F.2d 1340, 226 USPQ 683, 686 (Fed.Cir.1985). Thus, the rejection is impermissible.

In addition, Lee merely discloses receiving the RSSI and channel loading information (Lee, Abstract), not setting a plurality of RSSI thresholds or computing the RSSI value of the management message, as recited in claim 13. Unlike the term "receiving," the term "setting" requires activity.

Furthermore, Lee merely discloses selecting APs based on a set of conditions (Lee, paragraph [0011]), not placing an address of the station into a list identifying stations located in a potential coverage hole if none of the plurality of access points computes a RSSI value of the management message above the second RSSI threshold. The wireless station determines whether any AP exists that still meet the earlier threshold requirement, but having an RSSI value greater than or equal to -82 dBm. If so, then the wireless station selects the AP with the highest associated signal strength. If these second set of conditions are still not met, the AP having the lowest channel loading, while still having a signal strength greater than -82 dBm is selected. If no APs have signal strength greater than -82 dBm, none is selected (Lee, paragraph [0011]). While Lee discloses sets of conditions for selecting the APs, there is no teaching or suggestion of placing the address of the station into a list identifying stations in a potential coverage hole, as recited in the claim.

Given that Lee fails teach or suggest placing an address into a list, Lee further fails to teach or suggest removing the address of the station from the list if one of the plurality of access

points computes the RSSI value of the management message above the first RSSI threshold, as recited in claim 13.

Moreover, Lee discloses uses the RSSI and channel loading information to select an AP (Lee, Abstract). Lee aims to increase performance by ensuring that the AP with the strongest signal is also the busiest (Lee, Abstract). In contrast, the claims delineate that (i) if none of the plurality of access points computes a RSSI value of the management message above the second RSSI threshold, the address of the station is placed into the list and (ii) if one of the plurality of access points computes the RSSI value of the management message above the first RSSI threshold, the address of the station is removed from the list. The list identifies stations located in a potential coverage hole. Thus, while the RSSI is used to select an AP in Lee, the first and second RSSI threshold are used to maintain a list of stations which are located in a potential coverage hole.

The Examiner failed to establish the factual inquires in the three-pronged test as required by the *Graham* factual inquires. There are significant differences between the cited references and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of Eran and Lee in any combination.

Therefore, Applicant believes that independent claim 13 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §103(a) be withdrawn.

Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 13, and 15-17 are allowable over the prior art of record. Thus, Applicants respectfully submit that all the pending claims, namely claims 13, 15-17 and 21-25 are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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